



UNITED STATES DEPARTMENT OF COMMERCE
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SERIAL NUMBER	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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07/130,070 12/08/87 WARD

D ENZ-1 (CONT) D

EXAMINER

MARSCHEL, A

18N1

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345 PARK AVENUE
NEW YORK, NY 10154

ART UNIT

PAPER NUMBER

1807

31

DATE MAILED:

05/18/93

This is a communication from the examiner in charge of your application.
COMMISSIONER OF PATENTS AND TRADEMARKS

+ letter of 3-1-93

☒ This application has been examined ☒ Responsive to communication filed on 1/25/93 ☒ This action is made final.

A shortened statutory period for response to this action is set to expire 3 month(s), 0 days from the date of this letter.
Failure to respond within the period for response will cause the application to become abandoned. 35 U.S.C. 133

Part I THE FOLLOWING ATTACHMENT(S) ARE PART OF THIS ACTION:

- | | |
|---|--|
| 1. <input type="checkbox"/> Notice of References Cited by Examiner, PTO-892. | 2. <input type="checkbox"/> Notice re Patent Drawing, PTO-948. |
| 3. <input checked="" type="checkbox"/> Notice of Art Cited by Applicant, PTO-1449. <u>(26 sheets)</u> | 4. <input type="checkbox"/> Notice of Informal Patent Application, Form PTO-152. |
| 5. <input type="checkbox"/> Information on How to Effect Drawing Changes, PTO-1474. | 6. <input type="checkbox"/> |

Part II SUMMARY OF ACTION

1. ☒ Claims 126-130, 134-136, 141-143, 150-184 are pending in the application.
Of the above, claims _____ are withdrawn from consideration.
2. ☒ Claims 1-125, 131-133, 137-140, and 144-149 have been cancelled.
3. ☐ Claims _____ are allowed.
4. ☒ Claims 126-130, 134-136, 141-143, and 150-184 are rejected.
5. ☐ Claims _____ are objected to.
6. ☐ Claims _____ are subject to restriction or election requirement.
7. ☐ This application has been filed with informal drawings under 37 C.F.R. 1.85 which are acceptable for examination purposes.
8. ☐ Formal drawings are required in response to this Office action.
9. ☐ The corrected or substitute drawings have been received on _____. Under 37 C.F.R. 1.84 these drawings are ☐ acceptable. ☐ not acceptable (see explanation or Notice re Patent Drawing, PTO-948).
10. ☐ The proposed additional or substitute sheet(s) of drawings, filed on _____ has (have) been ☐ approved by the examiner. ☐ disapproved by the examiner (see explanation).
11. ☐ The proposed drawing correction, filed on _____, has been ☐ approved. ☐ disapproved (see explanation).
12. ☐ Acknowledgment is made of the claim for priority under U.S.C. 119. The certified copy has ☐ been received ☐ not been received
☐ been filed in parent application, serial no. _____; filed on _____.
13. ☐ Since this application appears to be in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11; 453 O.G. 213.
14. ☐ Other

EXAMINER'S ACTION

Applicants' arguments filed 1/25/93 and letter on 3/1/93 have been fully considered but they are not deemed to be persuasive to overcome the previously applied rejections. Rejections and/or objections not reiterated from previous office actions are hereby withdrawn. The following rejections and/or objections are either reiterated or newly applied. They constitute the complete set presently being applied to the instant application.

The following is a quotation of the first paragraph of 35 U.S.C. § 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

The specification is objected to under 35 U.S.C. § 112, first paragraph, as the specification, as originally filed, does not provide support for the invention as is now claimed.

Claim 184 does not limit each resistance gene practice to specific microorganisms as originally filed and thus contains NEW MATTER in this increased scope indicating that any of the microorganisms contain any of the cited resistance genes.

Claim 184 is rejected under 35 U.S.C. § 112, first paragraph, for the reasons set forth in the objection to the specification. This is a new ground of rejection necessitated by amendment.

Claims 126-130, 134-136, 141-143, and 150-184 are rejected

under 35 U.S.C. § 112, first paragraph, as the disclosure is enabling only for claims limited to modification of purines (claim moiety B) only at the 7-position of 7-deazapurines or modification of pyrimidines (claim moiety B) at the 5-position. This rejection is reiterated and maintained from the previous office action directed to the non-enablement of the C-8 purine modification and applied to newly added claims as necessitated by amendment. This rejection is based on the fact that only mercuration is instantly cited for the method of modification of nucleotide bases. Applicants have not argued that any other enablement is instantly disclosed but point to several prior art references to enable said C-8 modification. Since the C-8 modification is a clearly critical claim limitation and as such essential material to the practice of that limitation its enablement must be instantly disclosed. The mercuration teaching does not include reference or suggestion directed to other modification methods and thus does not lead one of ordinary skill to the essential material to practice the C-8 modification therefore supporting the continued application of this rejection. See M.P.E.P. §§ 706.03(n) and 706.03(z).

Claim 183 is rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. This is a new ground of rejection necessitated by amendment.

The triple bonded oxygen and triple bonded carbon atoms

given in the structure in claim 183 appears to be incorrect in that the hydroxyl probably should be directed to the triple bonded carbon thus making it bonded to four atoms and also making the oxygen bonded to only two atoms. This change is suggested to cite a structure that fits with normal organic molecules of this type.

Claims 126-130, 134-136, 141-143, and 150-184 are allowable over the prior art of record for reasons of record.

No claim is allowed.

Applicants' amendment necessitated the new grounds of rejection. Accordingly, **THIS ACTION IS MADE FINAL.** See M.P.E.P. § 706.07(a). Applicants are reminded of the extension of time policy as set forth in 37 C.F.R. § 1.136(a). The practice of automatically extending the shortened statutory period an additional month upon the filing of a timely first response to a final rejection has been discontinued by the Office. See 1021 TMOG 35.

A SHORTENED STATUTORY PERIOD FOR RESPONSE TO THIS FINAL ACTION IS SET TO EXPIRE THREE MONTHS FROM THE DATE OF THIS ACTION. IN THE EVENT A FIRST RESPONSE IS FILED WITHIN TWO MONTHS OF THE MAILING DATE OF THIS FINAL ACTION AND THE ADVISORY ACTION IS NOT MAILED UNTIL AFTER THE END OF THE THREE-MONTH SHORTENED STATUTORY PERIOD, THEN THE SHORTENED STATUTORY PERIOD WILL EXPIRE ON THE DATE THE ADVISORY ACTION IS MAILED, AND ANY EXTENSION FEE PURSUANT TO 37 C.F.R. § 1.136(a) WILL BE CALCULATED FROM THE MAILING DATE OF THE ADVISORY ACTION. IN NO EVENT WILL THE STATUTORY PERIOD FOR RESPONSE EXPIRE LATER THAN SIX MONTHS FROM THE DATE OF THIS FINAL ACTION.

Papers related to this application may be submitted to Group 180 by facsimile transmission. Papers should be faxed to Group 180 via the PTO Fax Center located in Crystal Mall 1. The faxing of such papers must conform with the notice published in the Official Gazette, 1096 OG 30 (November 15, 1989).

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The CM1 Fax Center number is either (703) 308-4227 or (703) 305-3014.

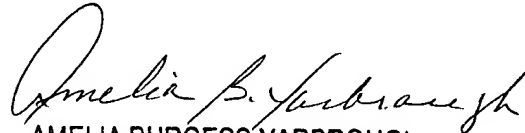
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ardin Marschel, Ph.D., whose telephone number is (703) 308-3894.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0196.

AM

A. MARSCHEL:am

May 17, 1993


AMELIA BURGESS YARBROUGH
PRIMARY EXAMINER
ART UNIT 187-1807